

## **R E M A R K S**

Claims 1-13 are pending in the application.

By the foregoing Amendment, claim 1 is amended to more specifically define the type of article to which the present invention is direct, and the context in which it is used, and claim 3 is amended to correct an obvious typographical error. Claims 2-11 also are amended for consistency with the amended preamble of claim 1. New claims 12 and 13 are added. The specification is amended to delete references to claim 1. The Abstract is amended to delete its introductory phrase.

Support for new claims 12 and 13 are found in paragraph 0016 of the specification and in Figure 1.

These changes are believed not to introduce new matter, and entry of the Amendment is respectfully requested.

Based on the above Amendment and the following Remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections, and withdraw them.

### **Objections to the Disclosure**

In paragraph 1 of the Office Action, the Abstract was objected to due to inclusion of the phrase “The invention relates to.” This objection is overcome by the above amendment to the Abstract to delete the phrase “The invention relates to.”

In paragraph 2, the disclosure was object to due to reference to claim 1 in the specification. This objection is overcome by the above amendments to paragraphs 0001 and 0004 of the specification to delete the references to claim 1.

Rejection under 35 U.S.C. § 112, ¶ 1

In paragraph 4 of the Office Action, claim 4 was rejected on the basis that “The specification does not describe in anyway the control device having a drive for displacing the cutting elements.” This rejection is respectfully traversed.

The Examiner’s attention is directed to paragraph 0008 on page 3 of the specification, which states:

A preferred cutting device is also characterized in that the control device has a drive for the displacement of the cutting element. Such a drive can e.g. be constructed as a hydraulic, rack and pinion or cam control drive. In particularly preferred manner the control device is operable by a force exerted by the outcropping ground during rotary operation. The force can in particular be a frictional force, which occurs between at least one of the cutting elements and the outcropping ground and/or between the control device and the outcropping ground. This leads to a particularly reliable rotation direction-dependent displacement of the cutting elements.

It is respectfully submitted that this description of the control device as having a drive that can be constructed as a hydraulic, rack and pinion or cam control drive, which preferably is operable by a force exerted by the outcropping ground during rotary operation, is sufficient to comply with the requirement of section 112, paragraph 1.

Rejections under 35 U.S.C. § 102

In paragraph 6 of the Office Action, claims 1-3 and 5-11 were rejected under section 102(b) as being anticipated by Smith et al. This rejection is respectfully traversed as being based on a reference that does not anticipate the claimed invention.

The present application as recited in independent claim 1 relates to a trench wall cutter for cutting trenches in the ground in order to carry out underground construction work, having at least one cutting wheel drivable in rotary manner and at least one first cutting element, located on the cutting wheel, for removing soil material during a rotation of the cutting wheel in a first rotation direction. On the cutting wheel is provided at least one second cutting element for removing soil material in an oppositely directed, second rotation direction, at least one of the cutting elements being displaceably mounted between a first position for removing soil material and a retracted, second position and a control device is provided for the displacement of the cutting elements between the first position and the second position.

Smith et al. discloses a sidebank excavator for removing earth from the side of a hill or other embankment, the excavator having a fixed, bidirectional horizontal earth removal assembly; a rotating, bidirectional vertical earth removal assembly; a conveyor assembly for conveying particulate material deposited on a receiving portion thereof to a discharge portion thereof remote from the receiving portion; and a plurality of independently vertically adjustable track drive assemblies.

As shown by Published U.S. Patent Appl. No. 2004/0234345 and U.S. Patents Nos. 5,964,305, 5,924,222, and 5,035,071 (all of which are made of record by the accompanying

Information Disclosure Statement), and U.S. Patent No. 4,834,197 (which was made of record in the Information Disclosure Statement submitted on July 26, 2004), “trench wall cutter” is a term of art that is used to denote a cutting device for cutting trenches in the ground, which device is introduced *vertically* into the soil in order to carry out underground construction work. Contrary to the subject matter of the present invention, Smith et al. is not directed to a trench wall cutter for cutting trenches in the ground, in order to carry out underground construction work. The device described in Smith et al. is a sidebank excavator for horizontally removing earth from the side of a hill or other embankment. This is a typical application in open-cast mining and not in in-ground construction work as addressed in the present invention as recited in claim 1. The two types of devices are as distinct from each other as a table is from a chair. The Smith et al. sidebank cutter and the trench wall cutter of the present invention are both pieces of earth-working machinery, just as a table and chair are both pieces of dining furniture, but they have entirely different functions and are not interchangeable.

It is accordingly respectfully submitted that Smith et al. cannot anticipate the invention as recited in claims 1-3 and 5-11, and that the invention as recited in claims 1-3 and 5-11 is patentable over Smith et al.

#### Claims 12 and 13

New claim 12 depends from claim 1, and recites that there are two cutting wheels, the cutting wheels being constructed in directly juxtaposed manner with parallel rotation axes. New claim 13 also depends from claim 1, and recites that the trench wall cutter further comprises a frame, wherein

there are two cutting wheels positioned at the bottom of the frame and fixed to the frame in rotary manner. It is respectfully submitted that these features of the present invention are not taught or suggested by Smith et al.; and that therefore, the invention as recited in claims 12 and 13 is patentable over Smith et al., independent of the patentability of claim 1, from which they depend.

Conclusion

All objections and rejections have been complied with, properly traversed, or rendered moot. Thus, it now appears that the application is in condition for allowance. Should any questions arise, the Examiner is invited to call the undersigned representative so that this case may receive an early Notice of Allowance.

Favorable consideration and allowance are earnestly solicited.

Respectfully submitted,

JACOBSON HOLMAN PLLC

By:



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